

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** KLASS W. DE GROOT

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Appeal No. 97-2222  
Application 08/380,661<sup>1</sup>

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ON BRIEF

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Before COHEN, MEISTER, and STAAB, ***Administrative Patent Judges.***

Meister, ***Administrative Patent Judge.***

***DECISION ON APPEAL***

This is an appeal from the final rejection of claims 12,  
14, 15 and 17. Claims 13 and 16, the only other claims

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<sup>1</sup>Application for patent filed January 30, 1995. According to appellant, this application is a divisional of application 08/045,875, filed April 15, 1993, now U.S. Patent No. 5,391,114, issued February 21, 1995.

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remaining in the application, stand allowed.<sup>2</sup>

The appellant's invention pertains to a nail element which is used for fastening together nailable building components. Independent claim 12 is further illustrative of the appealed subject matter and reads as follows:

12. A nail element comprising:

a plate-shaped body in a strip-form having head end edges and lateral edges;

a plurality of elongated elements, wherein at least a number of said plurality of elongated elements are fixedly secured against the lateral edges of the plate-shaped body at a point located between opposite ends of said elongated elements such that said elongated elements sufficiently protrude from opposite surfaces of said plate-shaped body to function as the nail element.

The reference relied on by the examiner is:

Atwell	1,511,711	Oct. 14,
1924		

Additional references relied on in this decision are:

Hallock (Hallock '967)	3,466,967	Sep. 16,
1969		
Hill	3,950,816	Apr. 20,

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<sup>2</sup>Page 2 of the answer states that "claims 13 and 16 are allowable as amended in the Supplemental After Final Amendment." By "Supplemental After Final Amendment," the examiner is apparently referring to the amendment filed concurrently with the brief. We observe, however, that this amendment has neither been given a separate paper number nor clerically entered.

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1976  
Hallock (Hallock '802) 4,031,802 Jun. 28,  
1977

Claims 12, 14, 15 and 17 stand rejected under 35 U.S.C.  
§ 102(b) as being anticipated by Atwell.

The examiner's rejection is explained on page 3 of the  
final rejection. The arguments of the appellant and examiner  
in

support of their respective positions may be found on pages 4-  
8 of the brief and pages 4-6 of the answer.

#### **OPINION**

We have carefully reviewed the appellant's invention as  
described in the specification, the appealed claims, the prior  
art applied by the examiner and the respective positions  
advanced by the appellant in the brief and by the examiner in  
the answer. As a consequence of this review, we will (1)  
sustain the rejection of claims 12 and 14, (2) reverse the  
rejection of claims 15 and 17 and (3) pursuant to our

authority under the provisions of 37 CFR § 1.196(b), enter a new rejection of claims 15 and 17 under 35 U.S.C. § 103.

Considering first the rejection of claims 12 and 14, it is the examiner's position that

Atwell discloses a nail element comprising a plate-shaped body (5, 6 or 11) having head edges (the ends of the members facing in and out of the page) and lateral edges. A plurality (two) of elongated members (1, 2) each attached at a middle region between their ends to the lateral edges of the plate-shaped body member such that they protrude therefrom to function as a nail. [Final rejection, page 3.]

It is the appellant's position that

The ATWELL reference describes a twin nail system that detachably connects two nails 1, 2 to each other through the use of frangible, break-away cross-bars 10, 11 or 5, 6 (column 1, lines 32-38 and 95-102). The crossbars are "only lightly secured to the nails 1 and 2 (page 1, lines 95-103 and page 2, lines 50-54).

Hence, the cross bars in ATWELL do not form a part of the operable nail element, but rather serve only to function as a spacer for the two nails (page 1, lines 33-38).

In ATWELL, only the embodiment of Figures 4 and 5 make use of rigidly secured cross bar 10. However, the cross bar 10 is secured to the nails immediately below the nail heads (page 2, lines 40-44). As shown in ATWELL's drawing figures, the nails 1, 2 are all attached to the head-end edges of the bars 5, 6, 10 and 11. As stated in

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ATWELL, it is the extremities of the bars 5, 6 which are only lightly secured to the nails (page 1, lines 95-97). [Brief, pages 4 and 5.]

We are unpersuaded by the appellant's arguments. The terminology in a pending application's claims is to be given its broadest reasonable interpretation (**see *In re Zletz***, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)) and limitations from a pending application's specification will not be read into the claims (**see *Sjolund v. Musland***, 847 F.2d 1573, 1581-82, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988)). Moreover, anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. **See *Verdegaal Bros., Inc. v. Union Oil Co.***, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987), **cert. denied**, 484 U.S. 827 (1987). A prior art reference anticipates the subject matter of

a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently (**see *Hazani***

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**v. Int'l Trade Comm'n**, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997)); however, the law of anticipation does not require that the reference teach what the appellant is claiming, but only that the claims on appeal "read on" something disclosed in the reference (**see Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), **cert. denied**, 465 U.S. 1026 (1984)).

It is true that in Atwell the elongated elements or nails 1, 2 are only temporarily secured to the "plate-shaped bodies" or bars 5, 6 or 11 and do not form a part of the "nail element" in its final assembled state. We must point out, however, there is no claim limitation which would preclude Atwell's arrangement and it is well settled that features not claimed may not be relied upon in support of patentability. **In re Self**, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). That is, independent claim 12 only broadly requires that the plurality of elongated elements be "fixedly secured" against the lateral edges of the plate-shaped body, and the mere fact that the bars or plate-shaped bodies 5, 6 or 11 of Atwell are described as being "lightly secured," does not preclude them

from also being "fixedly secured."<sup>3</sup> In this regard Atwell, while stating that the extremities (i.e., the lateral edges) of the bars 5, 6 (i.e., plate-shaped bodies) are only "lightly secured" to the nails 1 and 2, further states that these bars or plate-shaped bodies (1) serve to hold the two elongated elements or nails together during initial driving until such time that the bars or plate-shaped bodies come into contact with the shingles or sheathing into which they are being driven and (2) upon further driving, the bars or bodies are broken away, thus allowing the elongated elements or nails to become fully seated (see page 1, lines 95-105; page 2, lines 18-31). Clearly, bars or bodies which are sufficiently "secured" to hold the elongated elements or nails together during initial driving and only "break away" when the bars or bodies contact the surface of the article into which the nails are being driven, can be considered to be "fixedly secured" as broadly claimed.

In view of the foregoing, we will sustain the rejection

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<sup>3</sup>The American Heritage Dictionary, Second College Edition, 1982, Houghton Mifflin Company, Boston, MA, defines "fix" as -- b. To make fast to; attach --.

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of claims 12 and 14 under 35 U.S.C. § 102(b) as being anticipated by Atwell.

Turning to the rejection of claims 15 and 17 under 35 U.S.C. § 102(b) as being anticipated by Atwell, the appellant argues that Atwell's elongated elements or nails are not "beveled asymmetrically" as claimed. On the other hand, the examiner contends that

The right edge forming the tip of the nail in each said figures is shown to extend a slightly shorter distance towards the head of the nail than the one on the left thus making the edge where the right side of the tip meets the shaft slightly more angled and hence the tip asymmetrically beveled.

Furthermore, nails are mass produced with the pointed ends being formed thereon in a less than precise cutting step which leads to at least a slight asymmetric beveling. Exact symmetry is not cost effective and generally not critical. Since Atwell is silent on the formation of the nail ends it would be a reasonable **assumption** that the ends were formed in the "conventional" manner thus making them asymmetrically beveled. [Emphasis ours.]

We will not support the examiner's position. Atwell neither states nor clearly shows that the ends of his nails are asymmetrically beveled. As to the examiner's "assumption"



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that the Atwell's nail ends are made in a "conventional" manner which would inherently result in a "slight asymmetric beveling," we must point out that inherency may not be established by probabilities or possibilities (*In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)) and the fact that a certain thing **may** result from a given set of circumstances is not sufficient to

establish inherency (*In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)). Since each and every element set forth in dependent claims 15 and 17 cannot be found either explicitly or under the principles of inherency in Atwell (*see Hazani v. Int'l Trade Comm'n, supra*), we will not sustain the examiner's rejection of claims 15 and 17 under 35 U.S.C. 102(b).

Under the provisions of 37 CFR § 1.196(b) we make the following new rejections.

Claims 15 and 17 are rejected under 35 U.S.C. § 103 as being unpatentable over Atwell in view of Hallock '967, Hill

and Hallock '802. As we have noted above, there is no clear teaching in Atwell of an asymmetric bevel on the ends of his elongated elements or nails 1, 2. However, Hallock '967 at 23 (Fig. 13), Hill at 32 (Fig. 4) and Hallock '802 at 40 (Figs. 8 and 9) collectively establish that it was well-known in the art to provide an asymmetric bevel on the ends of elongated fastening elements such as nails. In view of these teachings, the artisan would have found it obvious as a matter of common sense<sup>4</sup> to

provide an asymmetric bevel on the ends of the elongated elements 1, 2 of Atwell if, for no other reason, than to achieve the self-evident advantage of ease of manufacture<sup>5</sup> vis-à-vis Atwell's "pointed" ends.

In summary:

The rejection of claims 12 and 14 under 35 U.S.C. §

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<sup>4</sup>The conclusion of obviousness may be made from "common knowledge and common sense" of the person of ordinary skill in the art. **See *In re Bozek***, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)).

<sup>5</sup>Indeed, Hill even expressly recognizes such an advantage (see column 4, lines 44-47).

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102(b) is affirmed.

The rejection of claims 15 and 17 under 35 U.S.C. §  
102(b) is reversed.

A new rejection of claims 15 and 17 is made under 35  
U.S.C. § 103.

In addition to affirming the examiner's rejection of one  
or more claims, this decision contains a new ground of  
rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec.  
1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197  
(Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63,  
122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new  
ground of rejection shall not be considered final for purposes  
of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b)  
provides:

(b) Appellant may file a single request for  
rehearing within two months from the date of the  
original decision . . . .

37 CFR § 1.196(b) also provides that the appellant,  
WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise  
one of the following two options with respect to the new

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ground of rejection to avoid termination of proceedings (37  
CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the  
claims so rejected or a showing of facts relating to  
the claims so rejected, or both, and have the matter  
reconsidered by the examiner, in which event the  
application will be remanded to the examiner. . . .

(2) Request that the application be reheard  
under § 1.197(b) by the Board of Patent Appeals and  
Interferences upon the same record. . . .

Should the appellant elect to prosecute further before  
the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in  
order to preserve the right to seek review under 35 U.S.C. §§  
141 or 145 with respect to the affirmed rejection, the  
effective date of the affirmance is deferred until conclusion  
of the prosecution before the examiner unless, as a mere  
incident to the limited prosecution, the affirmed rejection is  
overcome.

If the appellant elects prosecution before the examiner  
and this does not result in allowance of the application,  
abandonment

or a second appeal, this case should be returned to the Board

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of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**AFFIRMED-IN-PART**  
**37 CFR § 1.196(b)**

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
JAMES M. MEISTER	)	APPEALS AND
Administrative Patent Judg	)	INTERFERENCES
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	)	
LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	

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